

**REMARKS****1. Claim Amendments.**

The claims have been reviewed and amended for clarity so as to address the examiner's concerns under 35 USC 112 and Applicant requests that the examiner withdraw the objection to claims based on 35 USC 112.

Claim 1 has been amended by reordering the steps into a more logical order and by adding some clarifying language so as to make the claim more readable. Claim 1 also has been amended to include process steps for the film reel and the material reel. All of the changes are supported by the Specification as originally filed and no new matter has been entered.

Claim 6 has similarly been amended by reordering the elements into a more logical arrangement and by adding some clarifying language so as to make the claim more readable. Claim 6 also has been amended to include the film reel and the material reel elements. All of the changes are supported by the Specification as originally filed and no new matter has been entered.

Claims 21 and 22 have been amended in a fashion similar to Claims 1 and 6, respectively. All of the changes are supported by the Specification as originally filed and no new matter has been entered. Claims 21 and 22 also have been amended to include language that whereby the printing or markings (24) of the tear-open strips (12) are positioned in a precise position relative to the blank (11) to clarify that the process and apparatus are used to position the tear-off strips in a specific location on the blank. Support for this change can be found on page 5, line 14 through page 6, line 21 of the Specification as originally filed and no new matter has been entered.

**2. Reinstatement of Withdrawn Claims.**

Applicant submits that Claims 1, 6, 21, and 22 are allowable and generic and that the withdrawn claims should be reinstated. Specifically, under 37 CFR 1.142(b):

Claims to the invention or inventions not elected, if not canceled, are nevertheless withdrawn from further consideration by the examiner by the

election, subject however to reinstatement in the event the requirement for restriction is withdrawn or overruled.

Should Claims 21 and 22 be deemed allowable, Applicant reserves the right to add new dependent claims that depend from Claims 21 and 21 that are based on Claims 2-5 and 7-20, respectively.

### **3. Explanation of the Invention Relative to the Current State of the Art.**

The present invention relates to a process and apparatus for producing outer wrappers for items such as cigarette packs. The outer wrapper typically consists of a transparent film that is processed in a packaging machine as a continuous film web. A tear-open strip, which is later used to open the outer wrapper, is applied to the continuous film web during the blank production process for the outer wrapper. This generally is known in the art.

A unique feature of the present invention is that the tear-open strip comprises printing or markings. The printing or markings can take the form of decorative elements, written notices, informative text, printing marks, colored highlights, colored grip ends, or the like. This printing or markings are applied to the tear-open strip at some prior time. During the production of the outer wrapper, the film web for forming the base of the outer wrapper is drawn from a first reel and the material strip for producing the tear-open strip and having the appropriate and desired printing material is drawn from a second reel. Both materials are provided independently of each other and the material strip is applied to the continuous film web. Then, individual outer wrapper blanks with tear-open strips are severed from the film web. The blanks comprise a portion of the film web with a portion of the material strip applied thereto as the tear-open strip.

One problem addressed by the present invention is a way to ensure that the printing or markings on the tear-off strip is located at a predetermined specific position within the outer wrapper when the outer wrapper is applied to the pack. For example, it may be desired to position text information proximal to the pack's front side to gain the immediate attention of the consumer. In another example, it may be desired to position the tear-strip grip tab proximal to the narrow side surface or the edge of the pack.

To solve this problem, the present invention uses a printed-mark reader that senses (detects) the printing or markings on the tear-off strip. This information (that is, the detecting of the printing or markings) is evaluated and used to position the tear-off strip correctly on the film web, thus ensuring the desired positioning of the printing on the outer wrapper. For example, as shown in FIG. 2, the severing of the blanks after the material strip for the tear-off strip has been applied to the film web is controlled in accordance with the sensed printing on the tear-off strip. In this way, the blanks are severed such that the printing or markings on the tear-open strip are located at a certain position relative to the blank.

#### 4. 35 USC 103 Rejections.

Claims 1, 6, 21, and 22, as well as Claims 2-5 and 7-20, of the present patent application are not obvious over US Patent No. 3551245 to Gamberini (Gamberini '245) in view of US Patent No. 5470300 to Terranova (Terranova '300) because the present invention is patentably distinct over the cited patents and any combination of the cited patents. More specifically, the present process and apparatus is functionally and structurally nonobvious over the combination of references. As clarified, the claims disclose and claim a process and apparatus patentably distinct from the cited art, both in function and in structure.

For a claim to be determined obvious (or nonobvious) under 35 USC 103, the claimed material must have been obvious to person of ordinary skill in the art from the prior art. An obviousness determination requires examining (1) the scope of the *prior art*, (2) the *level of skill* in the art, and (3) the *differences* between the prior art and Applicant's invention. *Litton Systems, Inc. v. Honeywell, Inc.*, 117 SCt 1270 (1970). A mere suggestion to further experiment with disclosed principles would not render obvious an invention based on those principles. *Uniroyal, Inc. v. Rudkin-Wiley Corp.*, 19 USPQ2d 1432 (Fed. Cir. 1991). In fact, an applicant may use a reference as a basis for further experimentation and to create the invention. *Id.* Upon an examination of these three factors, the present invention is not obvious in view of the cited art.

The fact that each element in a claimed invention is old or unpatentable does not determine the nonobviousness of the claimed invention as a whole. *See Custom*

*Accessories, Inc., v. Jeffrey-Allan Industries*, 1 USPQ2d 1196 1986 (Fed. Cir. 1986). The prior art must not be given an overly broad reading, but should be read in the context of the patent specifications and *as intended by reference authors*. *Durling v. Spectrum Furniture Co.*, 40 USPQ2d 1788 (Fed Cir 1996) (Federal Circuit held that district court erred by giving a "too broad an interpretation" of claims in a sofa patent to invalidate another on the nonobviousness standard). The cited prior art does not include all of the steps, elements or features of the present invention as claimed.

The Federal Circuit has made it clear that the nonobviousness standard is applied wrongly if a court or an examiner (1) improperly focuses on "a combination of old elements" rather than the invention as a whole, (2) ignores objective evidence of nonobviousness, (3) pays lip service to the presumption of validity, and (4) fails to make sufficient *Graham* findings. *Custom Accessories, Inc.*, 1 USPQ2d 1196 (Fed. Cir. 1986). Applying the nonobviousness test counter to these principles counters the principle that a patent application is presumed nonobvious. *Id.* Further, to sustain a rejection under 35 USC 103, the examiner must establish a *prima facie* case of obviousness. MPEP §2142. To establish a *prima facie* case of obviousness, the prior art reference (or references when combined) must teach or suggest all the claim limitations. MPEP §2143. This is not the case with the cited art.

Gamberini '245 discloses the application of a tear-open strip to a material web. In Gamberini '245, the tear-open strip first is cut from a lateral edge of the material web so that it can be folded over and reattached to the material web as a double-layer **reinforced** tear-open strip. In the process, the material web and the tear-open strip are drawn off of a common reel and then guided over separate rollers in order to carryout the folding of the tear-open strip. In addition, after the tear-open strip is severed from the material, a marking is applied to the tear-open strip at **pre-determined intervals** for marking the grip end of the tear-open strip. In contrast to the present invention, therefore, a separate, pre-fabricated tear-open strip is not used, but instead the tear-open strip is produced and printed directly at the production site.

Further, Gamberini '245 does not make use of a printed mark and a printed-mark reader. Nor would use of such devices be suitable for Gamberini '245. Gamberini '245 proceeds from the assumption that the U-shaped notches (19) are to be applied to the

material web and also that the colored sections (E) are to be applied to the tear-open strip at pre-determined intervals. Correspondingly, the elements of the Gamberini '245 apparatus are "equally spaced" or "so mounted" such that the grip end is located precisely at the position of the notches (19) after the tear-open strip is applied. See Gamberini '245 column 3, lines 22-26 and 30. Consequently, the use of a printed-mark reader is not necessary and makes little sense, as such a measure does not improve the positioning of the tear-open strip. In Gamberini '245, the problem of achieving the exact arrangement of the tear-open strip is solved by providing the tear-open strip with the markings only after it has been severed from the material web, at which point the marking can be applied in its precise position. On the contrary, in the present invention, a pre-inked or pre-marked tear-open strip that cannot be modified is used.

Terranova '300 discloses the use of printed marks and printed-mark readers for the control of a severing cut for severing individual blanks from a continuous material web for manufacturing plastic bags. Terranova '300 merely discloses the use of a printed-mark reader associated with a material web or film and does not discuss or disclose the problem addressed or solution claimed in the present patent application. More specifically, Terranova '300 does not even relate to the field of the present invention (producing plastic bags that you do not want to rip versus producing tear-off strips for wrappers that you do want to rip) or to the control of the relative position of a material strip that is attached to a continuous film web and that is used as an opening aid for a film wrapper. As Terranova '300 does not disclose any material strips attached to the film web, Terranova '300 does not need to and does not address the problem of coordinating the printing of the tear-strip with the printing on the film web. Finally, Terranova '300 does not sense markings on a tear-open strip.

Further, those of ordinary skill in the art would not combine Gamberini '245 with Terranova '300. If someone of ordinary skill in the art did have Gamberini '245 and Terranova '300 before them, they would not arrive at the present invention. The combination of Gamberini '245 and Terranova '300 does not result in the present invention and, without using the present invention as a hindsight tool, fails in every respect to lead to the present invention. Thus, without Applicant's disclosure of the inventive step, one of ordinary skill would not have designed a process or apparatus in which tear-off strips

comprise printing or markings for the purpose of controlling the relative position of the tear-off strip and its printing on an outer wrapper blank to cover packs.

In summary, the present invention is not obvious over the cited art because it is a patentably distinct invention that is combination of features not disclosed by the prior art. As such, Applicant's requests that the examiner withdraw the rejection to Claims 1, 6, 21 and 22.

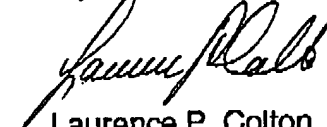
### **CONCLUSION**

Applicant believes it has fully addressed the examiner's concerns and the claims are in condition for allowance, and Applicant respectfully requests such action.

Applicant further requests that the examiner reinstate Claims 2-6 and 7-20 as Claims 1 and 6 are generic regarding at least having tear-open strips that comprise printing or markings for the purpose of controlling the relative position of the tear-open strip and its printing on an outer wrapper blank to cover packs.

If the examiner has any final concerns that can be addressed over the telephone, the examiner is invited to contact the below-signed attorney of record.

Respectfully submitted,  
POWELL GOLDSTEIN LLP



Laurence P. Colton  
Reg. No. 33,371

POWELL GOLDSTEIN LLP  
1201 West Peachtree Street, NW  
14<sup>th</sup> Floor  
Atlanta GA 30309-3488

Tel: 404.572.6710  
Fax: 404.572.6999  
E-Mail: lcolton@pogolaw.com